

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

I. Disposition of Claims

Claims 29-48 are pending in this application. Claims 29 and 40 are independent. The remaining claims depend, directly or indirectly, from claims 29 and 40. Additionally, claims 29 and 40 have been amended in this reply. No new matter has been added by way of these amendments.

II. Rejection under 35 U.S.C. § 103

Claims 29-48 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,581,149 ("Xidos") in view of U.S. Patent No. 6,336,095 ("Rosen") and further, in view of U.S. Patent No. 6,422,941 ("Thorner"). Claims 29 and 40 have been amended in this reply to clarify the present invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

The Applicant respectfully notes that in order to establish a prima facie case of obviousness, the cited prior references must satisfy two criteria:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. (MPEP §2143)

The Applicant respectfully asserts that (1) Xidos, Rosen, and Thorner, whether considered separately or in combination, do not teach *all* of the limitations of the claimed invention and (2) there is no motivation to combine Xidos, Rosen, and Thorner, and consequently, such a combination of the above references does *not* provide any reasonable expectation of success.

A. Xidos, Rosen and Thorner Do *Not* Teach *All* of the Elements of Claims 29 and 40

(1) Live Action Broadcast Event

Claims 29 and 40 as amended requires “a *live-action* broadcast event, wherein the an outcome of the broadcast event is not produced in response to a user.” Xidos does not teach using broadcast audio-visual data relating to a live-action broadcast event, as recited in claims 29 and 40. Rosen and Thorner fail to provide that which Xidos lacks. In one or more embodiments, a live action broadcast event includes televised sporting events, *etc.*

In particular, the tutorial (or simulation) session as taught by Xidos and the demonstration mode as taught by Thorner are not live-action broadcast events, where the user does not effect the outcome of the events. The simulation session and demonstration mode taught by these references are typically pre-recorded programs. Finally, Rosen is completely silent to a live-action broadcast event. Therefore, Xidos, Rosen, and Thorner do not teach a live-action broadcast event as required by independent claims 29 and 40.

(2) Subscription Card Reading Device

Claim 29 as amended requires a receiver/decoder including “a *subscription card reading device* for interacting with a user’s subscription card for providing user access to

the live-action broadcast event” and “*a bank card reading device* for interacting with a user’s bank card to read data stored thereon.” Similarly, claim 40 requires, “interacting with user’s subscription card for providing access to the live-action broadcast event” and “interacting with a user’s bank card to read data stored thereon.”

Xidos does not teach the use of both a subscription card reading device and a bank card reading device. Furthermore, Rosen and Thorner are completely silent to a subscription card reading device.

As previously stated, claims 29 and 40 both require the use of a subscription card reading device and a bank card reading device. The Applicant respectfully notes that a smart card having capability to provide subscription access and banking access means that the smart card can be used in either device. A smart card having dual capability does *not* mean that one of the devices in the claim language is not required, *i.e.*, the Examiner cannot exempt an element of the claim, namely a subscription card reading device.

Furthermore, the very basis of using a smart card in both the subscription card reading device and the bank card reading device was found in the Applicant’s disclosure in the summary of the invention (on page 2, line 5 to page 7, line 28), and thus, it is improper to apply this disclosure as prior art.

Therefore, Xidos does not teach a subscription card reading device or the use of a subscription card as required by claims 29 and 40.

B. There Is No Motivation to Combine Xidos, Rosen, and Thorner

In addition to Xidos, Rosen, and Thorner failing to teach all of the elements of claims 29 and 40, the Applicant asserts that there is no motivation to combine any or all

of these reference.

The Applicant respectfully reminds the Examiner that in order to be properly combinable there must be some teaching, whether explicit or implicit, within the references themselves to suggest such a combination (see, MEP §2143). The Examiner has failed to make such a showing, and therefore, the rejection is untenable and should be withdrawn.

Moreover, this entire rejection appears to be based on improper hindsight reconstruction. Even assuming *arguendo* that the references are properly combinable, the Applicant is aware of no line of reasoning and the Examiner provided none as to why a person of ordinary skill in the art would look to supplement the disclosure of Xidos with the teachings of Rosen or Thorner.

The Applicant respectfully reminds the Examiner that engaging in “pick and choose” rejections, whereby various aspects of the prior art are selected without regards to their respective teachings, is improper and does not result in a *prima facie* case of obviousness. Therefore, should the Examiner seek to maintain this rejection, the Applicant requests that the Examiner provides some reasoning behind this rejection that is supported by appropriate citation to the prior art.

III. Conclusion

Because Rosen, Xidos, and Thorner do not teach all of the elements of the claimed invention and there is no motivation to combine these references, Rosen, Xidos, and Thorner *cannot* render the claimed invention obvious. Therefore, claims 29 and 40 are patentable over Rosen, Xidos, and Thorner, whether considered separately or in

combination. Claims 28-39 and 41-48 are likewise patentable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345.025001).

Respectfully submitted,

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